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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,671	12/11/2001	Kevin P. Baker	GNE.2830P1C47	8003

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EXAMINER

HUNNICUTT, RACHEL KAPUST

ART UNIT PAPER NUMBER

1647

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,671

Applicant(s)

BAKER ET AL.

Examiner

Rachel Kapust Hunnicutt

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-35, 38-40 and 44-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-35, 38-40, and 44-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

Applicant's amendment filed June 25, 2004 is acknowledged. Claims 36-37 and 41-43 have been canceled. Claims 28-34, 38-39, and 46 are amended. Claims 48-54 are new. Claims 28-35, 38-40, and 44-54 are pending and under consideration. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

The declarations filed on June 25, 2004 under 37 CFR 1.131 have been considered but are ineffective to overcome the Jacobs *et al.* (2003/0096951) reference. A declaration filed under 37 CFR 1.131 must be signed by all of the inventors of the subject matter of the rejected claims. The declarations filed on June 25, 2004 were only signed by William Wood and Audrey Goddard.

Priority

Based on the information given by the Applicants and an inspection of the patent applications, the examiner has concluded that the subject matter defined in this application is supported by the disclosures in application serial nos. PCT/US00/04342, filed February 18, 2000 and PCT/US99/28313, filed November 30, 1999. Accordingly, the subject matter defined in claims 28-35, 38-40, and 44-54 has an effective filing date of November 30, 1999.

Claim Rejections/Objections Withdrawn

The objection to the specification regarding the use of trademarks is withdrawn in response to Applicants' amendments to the specification.

The rejection of claim 46 under 35 U.S.C. 101 for being directed to nonstatutory subject matter is withdrawn in response to Applicants' amendment to claim 46.

The rejection of claims 28-33, 37, and 41 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention is withdrawn in response to Applicants' amendments to the claims and the cancellation of claim 37.

The rejection of claim 42 under 35 U.S.C. 112, second paragraph, as being indefinite in the limitation "stringent conditions" is withdrawn in response to Applicants' cancellation of the claim.

The rejection of claims 28-32 and 41-47 under 35 U.S.C. 112, first paragraph, for lack of enablement, is withdrawn in response to Applicants' amendments to the claims reciting a functional limitation for the encoded polypeptides and the cancellation of claims 41-43.

The rejection of claims 28-32 and 41-47 under 35 U.S.C. 112, first paragraph, for lack of written description is withdrawn in response to Applicants' amendments to the claims reciting a functional limitation for the encoded polypeptides and the cancellation of claims 41-43.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-35, 38-40, and 44-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are drawn to isolated nucleic acid encoding polypeptides "capable" of stimulating endothelial cell growth or "capable" of inducing proliferation of kidney mesangial cells. By saying that the encoded polypeptides are "capable" of stimulating endothelial cell growth or "capable" of inducing proliferation of kidney mesangial cells, Applicants imply that there would be conditions under which the encoded polypeptides would not stimulate endothelial cell growth or induce proliferation of kidney mesangial cells. If the claims were meant to encompass conditions under which the encoded polypeptides did not stimulate endothelial cell growth or induce proliferation of kidney mesangial cells, one of skill in the art would not know how to use the encoded polypeptides under such conditions. The

rejection could be obviated by amending the claims so that they are drawn to nucleic acid molecules wherein the “encoded polypeptide stimulates endothelial cell growth or the polypeptide induces proliferation of kidney mesangial cells”.

Claim Rejections - 35 USC § 102

The rejection of claims 28-35, 38-40, and 44-47 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2003/0096951 (Jacobs *et al.*) is maintained for reasons of record on p. 6 of the previous office action. Claims 48-54 are newly rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2003/0096951 (Jacobs *et al.*). As stated above, the declarations submitted on June 25, 2004 are ineffective because they were not signed by all of the inventors of the rejected claims. Thus, the declarations cannot be considered as evidence. New claims 48-54 are drawn to nucleic acid molecules of at least 20, 50, 60, 70, 80, 90 or 100 nucleotides in length that hybridize to SEQ ID NO: 129. 2003/0096951 teaches SEQ ID NO: 3 which is 92.8% identical to SEQ ID NO: 129 and which encodes a polypeptide which is 100% identical to SEQ ID NO: 130. Thus, claims 28-35, 38-40, and 44-54 are anticipated by U.S. Patent Application Publication 2003/0096951.

Conclusion

NO CLAIMS ARE ALLOWED.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel Kapust Hunnicutt whose telephone number is (571) 272-0886. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RKH
8/19/04


JANET ANDRES
PRIMARY EXAMINER